

REMARKS

I. Introduction

Claims 19, 21, 22, 24-27 and 30-36 are currently pending in the present application after cancellation of claims 20, 23, 28 and 29. Applicants have amended claims 19, 21, 22, 27, 30 and 35-36. Entry of the claim amendments is requested since the amendments put all pending claims in condition for allowance and do not raise any new issue. In view of the following remarks, it is respectfully submitted that all pending claims are allowable, and reconsideration of these claims is respectfully requested.

II. Allowable Subject Matter

Claims 29 and 32 are objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, base claim 27 has been amended to incorporate the features of dependent claim 29 and intervening claim 28 (thereby essentially rewriting claim 29 in independent form to include the limitations of base claim 27 and intervening claim 28). Accordingly, claim 27 is in allowable condition. In addition, since pending dependent claims 30-36 are all ultimately dependent on allowable claim 27, Applicants submit that claims 30-36 are also in allowable condition.

III. Rejection of Claims 19-28, 30, 31 and 33-36 under 35 U.S.C § 103(a)

Claims 19-28, 30, 31 and 33-36 are rejected under 35 U.S.C § 103(a) as being obvious over WO 99/21261 A (which corresponds to U.S. Patent 6,208,931). Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior

art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

As noted above, amended claim 27 is now in allowable condition. In addition, claim 19 has been amended to recite apparatus limitations substantially identical to the claimed limitations recited in allowable claim 27, i.e., amended claim 19 now recites, in relevant parts, “means for determining power demands of an electrical system of the motor vehicle during idling; a pre-control unit for converting the power demands of the electrical system of the motor vehicle during idling into a setpoint torque of the internal combustion engine; . . . wherein a power output of the internal combustion engine is adjusted to an instantaneous power demand of the electrical system of the motor vehicle; and wherein the setpoint torque of the internal combustion engine is determined as a function of the instantaneous power demand of the electrical system of the motor vehicle, and at least one of an injection quantity, an air quantity, and an ignition angle of the internal combustion engine is adjusted according to the determined setpoint torque.” WO 99/21261 A and the corresponding U.S. Patent 6,208,931 clearly do not teach or suggest any of the above-recited claimed limitations, as implicitly acknowledged by the Examiner.

For at least the foregoing reasons, claims 19 and 27, as well as pending dependent claims 21, 22, 24-26 and 30-36, are allowable over the applied prior art.

IV. Conclusion

In view of all of the above, it is respectfully submitted that all of the presently pending claims are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

 (R-NO.
36,197)

Dated: July 9, 2009

By: SONG LEE for Gerard Messina
Gerard A. Messina
(Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646